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In the Matter of

CERTAIN DIGITAL SATELLITE
SYSTEM (DSS) RECEIVERS
AND COMPONENTS THEREOF

Investigation No. 337-TA-392

Order No. 50: Initial Determination Granting Motion for Summary Determination of
Invalidity of Claim 35 of the '277 Patent

On April 21, 1997, under Commission rule 210.18, respondents DIRECTV, Inc., United States Satellite Broadcasting Co., Inc., Hughes Network Systems, and Hitachi Home Electronics (America), Inc. (respondents) moved for summary determination that claim 35 of U.S. Patent No. 5,335,277 (the '277 patent) is invalid under 35 U.S.C. § 102(b) because the alleged invention of claim 35 was both described in a printed publication and on sale in the form of the Heathkit GR-2001 Programmable Television (Heathkit device), as sold by the Heath Company in 1976, and described in "intricate detail" in the manuals set and other materials published by the Heath Company in 1976, more than one year before the alleged November 3, 1981 effective filing date of the application for the '277 patent (Motion Docket No. 392-27).^{1 2}

¹ In support of Motion No. 392-27 movants submitted declarations of Professor V. Michael Bove, Jr., William E. Johnson and Ronald A. Antush, with supporting exhibits, and a statement of uncontroverted facts.

² Respondents Thomson Consumer Electronics, Inc., Toshiba America Consumer Products, Inc. and Matsushita Electric Corporation of America supported Motion No. 392-27 in a response dated May 7, 1997.

Complainant Personalized Media Communications, Inc. (PMC) on May 1, 1997, opposed Motion No. 392-27.

The staff on May 7, 1997, supported Motion No. 392-27.

On May 8, 1997, complainant moved to file a reply to respond to issues raised in the staff's response in support of Motion No. 392-27 for summary determination of claim 35 (Motion Docket No. 392-40). Motion No. 392-40 is granted.

On May 9, 1997, movants moved for leave to file a reply in view of complainant's opposition and complainant's reply to the staff's response (Motion Docket No. 392-43). Motion No. 392-43 is granted.

Claim 35 of the '277 patent reads:

35. A television subscriber station comprising:

a converter for receiving a multichannel television transmission;

a tuner operatively connected to said converter for selecting a specific television channel;

a television receiver or display device for displaying programming of a channel specified by said tuner; and

a controller operatively connected to said tuner for storing information of a selected television program unit and causing said tuner to select a television transmission containing programming of said selected television unit at a specific time.

(Emphasis added).

Movants argued that a review of the Heathkit GR-2001 Programmable Color TV, and the associated manual set, as well as the Heathkit Catalog and Radio-Electronics article, reveals that said Heathkit device includes, and thus discloses, all of the claimed elements of claim 35 of the '277 patent, citing Bove Decl. ¶¶ 26-32 and following claim chart below:

7 '277 Patent Claim 35	Heathkit GR-2001 Programmable Color TV
35. A television subscriber station comprising:	The Heathkit GR-2001 is a television subscriber station designed to permit connection to a CATV (Community Antenna TV) or an MATV (Master Antenna TV) cable system. See Bove Decl. ¶ 26 and Ex. C, Operations Manual (GR-2001 Book 3), page 3-46 and Fig. 1-35C.
a converter for receiving a multichannel television transmission;	The converter of the GR-2001 is the "B" portion of the UHF/VHF Tuner block shown in Figure 4-4, which consists of the element blocks A, B, C, D, F, G, H, J, K and L (other than Blocks M and E) in Figure 5-6. See Bove Decl. ¶ 29 and Ex. D. In particular, the Mixer (Block L) heterodynes a multichannel transmission with a signal received from a tunable local oscillator (Block M) to convert the transmission so that the selected channel corresponds to 45 MHZ. <i>Id.</i>
a tuner operatively connected to said converter for selecting a specific television channel;	The tuner of the GR-2001 is the "A" portion of the UHF/VHF Tuner block shown in Figure 4-4, which consists of the block labeled M (or in the case of UHF reception, the block labeled E) in Figure 5-6, page 5-39 of the Data Manual, as well as the following elements that are shown in Bove Decl. Ex. E: the circuit assembly labeled U-V Switching Circuit Board, the bank of tuning potentiometers on the Tuning Control Circuit Board, and Tuning Voltage Amplifier IC204. See Bove Decl. ¶ 28 and Ex. E. Figure 5-6 shows the "tuner" of the GR-2001 operatively connected to the "converter".
a television receiver or display device for displaying programming of a channel specified by said tuner; and	The television receiver or display device of the GR-2001 consists of the circuitry shown on the reverse (second) side of the GR-2001 Heathkit TV Schematic. See Bove Decl. ¶ 30 and Ex. E. The design follows a conventional approach in which the intermediate frequency (IF) signal is amplified, the video luminance and chrominance signals demodulated, the sync signals separated and used to generate scanning voltages, and after super position of a graphical display (if enabled) the appropriate signals are presented to the picture tube, V801. <i>Id.</i> See also Ex. D to Bove Decl., Data Manual (GR-2001 Book Five), pages 5-40 to 5-51. The picture tube displays the programming content of the selected channel.

<p>7</p> <p>'277 Patent Claim 35.</p>	<p>Heathkit GR-2001 Programmable Color TV</p>
<p>a controller operatively connected to said tuner for storing information of a selected television program unit and causing said tuner to select a television transmission containing programming of said selected television unit at a specific time.</p>	<p>The controller of the GR-2001 consists of the circuitry of the GRA-601 (Clock Manual, Pictorial 15, page 30), the circuitry of the GD-1185 (Programmer Schematic), and Channel Registers IC214 and IC219, Channel Selection Circuit Board, and potentiometer drivers IC202 and IC203 (Heathkit TV Schematic). See Bove Decl. ¶ 31 and Exs. E, F and H. This circuitry is operatively connected to the tuner as shown on the Heathkit TV Schematic. The Programmer has a static memory (IC-1116 on the Programmer Schematic), which is designed for storing the channel and time information of a selected television programming unit. <i>Id.</i> The precise format of this information is provided in Pictorial 8-2 and described on pages 114-115 of the Programmer Manual. See Ex. G to Bove Decl. The Programmer of the GR-2001 will select the channel of the television transmission containing the desired television programming unit at a specific time according to the operational sequence described on pages 116 and 117 of the Programmer Manual. Bove Decl. ¶ 31 and Ex. G.</p>

Movants argued that the last element of claim 35, viz. the "controller" is operatively connected to the tuner, which controls or directs the operation of the tuner in the television subscriber station; that, for example, in Figure 4 of the '277 patent, controller 20, which is part of signal processor 200, causes or directs changes in the channels selected by tuners 214 and 223 ('277 patent, col. 161, lns. 42-52; col. 165, lns. 48-55, citing Bove Decl. ¶ 19); that the controller is designed for storing information related to a particular television program unit; which information, called "selection information" by Complainant (Complaint ¶ 4.10), includes the specific start time of the television program unit and the channel on which that program unit will appear ('277 patent, col. 162, lns. 44-61); that a "television program unit" as used in claim 35 corresponds to a television program, i.e. an episode, such

as "The French Chef," ('725 patent, col. 2, ln. 66 - col. 3, ln. 4), or "Wall Street Week," ('277 patent, col. 162, lns. 44-49, citing Bove Decl. ¶ 19); that the time and channel information related to a program unit may be entered into the system through a keyboard, such as local input item 225 in Fig. 4 of the '277 patent, for storage and subsequent use by the controller ('277 patent, col. 161, lns. 56-68; col. 162, lns. 50-61, citing Bove Decl. ¶ 19); and that the controller of claim 35 is operatively connected to the tuner and, based upon pre-programmed selection information, directs the tuner to select and then display a television program unit (episode) at a specific time.

Complainant, relying on an attached Nathaniel J. Davis declaration in support of its opposition, argued that movants "improperly" interpret claim 35 as requiring a controller that stores only viewing channel and viewing time, rather than program specific information as required by the language of claim 35; that movants acknowledge that the Heathkit device determines what to display based solely on a viewing channel and viewing time entered by the user; that claim 35 expressly requires "a controller operatively connected to said tuner for storing information of a selected television program unit . . .;" that, as demonstrated to movants in complainant's discovery responses, one embodiment of a system which practices the elements of claim 35 is disclosed in relation to Figure 6C in U.S. Patent No. 4,694, 490 (the '490 patent) and Figure 7C of the '277 patent;³ that those figures include a "cable converter box 201," which receives a multichannel cable television transmission, a "tuner 214," which causes the converter to select a specific television channel, a "TV set 202" (or

³ Complainant noted that U.S. Patent No. 4, 694,490 issued from the application from which the '277 patent (the patent-in-suit) claims priority.

"TV monitor 202M"), which displays programming transmitted on the selected television channel, and a "microcomputer 205," which stores information that identifies a specific television program and causes the tuner to select the program at a specific time (Davis Decl. at ¶¶ 14-17); and that one example of a controller as required by claim 35 is described in the '490 patent at Col. 19: 5-25, citing also '277 patent Cols. 238: 55 - 244: 51, 165: 48-50; Davis Decl. at ¶ 18.

It is also argued by complainant that in one embodiment described in the '277 patent, microcomputer 205 is preinformed with "program-unit-of interest" information that "reflects the wish of the subscriber of said station to view (or record)" the program of interest when it is transmitted ('277 patent Cols. 238: 55-59, 239: 3-8); that microcomputer 205 subsequently receives instructions from the intermediate transmission station that contain *both* information of the subject matter of the television program unit (i.e., "specific-[Wall Street Week] information") *and* channel identification information (i.e., please-fully-enable-[Wall Street Week]-on-CC13-at-particular-8:30 information"); that the channel identification information indicates the channel on which the subscriber station will transmit a given program unit ('277 patent Cols. 240: 4-22, 240: 54 - 241: 17, 243: 22-36); that microcomputer 205 compares the information of the subject matter of the television program unit received from the intermediate station with "the information of a selected television program unit" stored in memory and if there is a match, microprocessor 205 inputs the channel identification information to controller 20, which then causes tuner 214 to tune to the proper channel ('277 patent Cols. 243: 37 - 244: 6, 165: 48-51).

Complainant argued that it is clear from the examples of the '490 and '277 patent specifications that the controller of claim 35 does not simply store the viewing time and channel of a desired television program unit, which may vary, citing '490 patent Col. 11: 18-31, '277 patent Col. 240: 4-22, but rather, the information stored by the controller includes content information that uniquely identifies the desired unit of programming, citing Davis Decl. at ¶¶ 18-19, '490 patent Cols. 2: 66 - 3:3, '277 patent Col.: 10: 19-20; and that the '490 and '277 patent specifications consistently distinguish "information of a selected television program unit" from channel and time information, citing '490 patent Col. 11: 18-30, '490 patent Col. 11: 3-7, '277 patent Col. 238: 55-64, '277 patent Col. 243: 32-36, and '277 patent Col. 162: 56-60. It is argued by complainant that the portion of the '490 specification cited by movants and their expert⁴ do not reference viewing time or viewing channel, but rather specifically states that programming units may be identified by unique codes, citing Davis Decl. at ¶ 26, Respondents' Brief at p. 7, Bove Decl. at ¶ 19, and '490 patent Cols. 2:66 - 3:3; and that movants ignore other portions of the specification which consistently distinguish between information uniquely identifying a program unit and the viewing time and viewing channel, which may vary for a given program unit.

The staff, in support of Motion No. 392-27, argued that the Heathkit device contains all the limitations of claim 35; that complainant has presented no evidence to contradict movants' contentions that the Heathkit device is a subscriber station, as specified in the preamble of claim 35, consisting of a converter for receiving a multichannel television

⁴ Complainant noted that movants cite to the specification of U.S. Patent No. 4,704,725 which is the same specification as that of the '490 patent.

transmission, a tuner for selecting a particular channel, and a television receiver or display device, citing Respondents' Statement of Uncontroverted Facts, ¶¶ 8-11, and Complainant's Response to Respondents' Statement of Uncontroverted Facts, ¶¶ 8-11; that complainant also does not appear to dispute that the Heathkit device included components, including a memory device, that together act as a controller to store channel and time information and cause the tuner to select a particular channel at a particular time,⁵ citing Respondents' Statement of Uncontroverted Facts, ¶ 12, and Complainant's Response to Respondents' Statement of Uncontroverted Facts, ¶ 12; and that there appears to be no dispute as to the capabilities of the Heathkit device or the disclosures contained in the references describing the Heathkit device but rather, the dispute lies in the proper interpretation of the phrase "information of a selected television program unit" as it is used in the last element of claim 35,⁶ and whether the Heathkit device's storage of channel and time information satisfies the claim language. It is argued by the staff that the time at which a television program is to be displayed and the channel on which it will be displayed constitutes "information of a selected television program unit" within the meaning of claim 35; that the plain meaning of the final element of claim 35 is that "information" stored in the controller must be at least sufficient to cause the tuner to select a specific program at a specific time; and that if the tuner has the correct time and channel information, no further information is needed to display a selected program at a specified time, which is all that the claim requires the controller and tuner to do.

⁵ The staff noted that the terms "television program unit" and "television unit" are not explicitly defined in either claim 35 or the specification of the '277 patent, but they appear to refer to a single television show such as "Wall Street Week." *citing*, '277 patent, col. 243, lines 41-48.

⁶ See claim 35, supra.

Movants, in their reply, argued that before complainant learned of the Heathkit reference, it had no trouble concluding that time-and-channel information qualified as "information of a selected television program unit" for purposes of claim 35; that in a July 10, 1996 letter to respondent Hughes Network Systems, complainant asserted that the HNS receivers now accused in this investigation infringed numerous claims of the '277 patent; that complainant attached claim charts to that letter, including a claim chart on claim 35; that complainant's entire explanation as to why the receivers had "a controller . . . for storing information of a selected television program unit" was as follows:

A DSS receiver processor receives information as to when and where a television show airs within the DSS multichannel signal. The DSS processor uses this information to tune the DSS to the desired television program unit at the desired time.

(Emphasis added.) Hence it is argued that complainant's position, before it knew it must avoid the Heathkit reference, was that the "information of a selected television program unit" requirement could be satisfied by time ("when") and channel ("where a television show airs within the multichannel signal") information about a desired program.

Commission rule 201.18(a) provides that "[a]ny party may move with any necessary supporting affidavits for a summary determination in his favor upon all or any part of the issues to be determined in the investigation." The administrative law judge must render a decision in favor of the moving party if the pleadings, and any depositions, answers to interrogatories, and admissions on file, together with any affidavits submitted in support of or in opposition to the motion for summary determination, show that there is no genuine issue of material fact and that the moving party is entitled to summary determination as a matter of law. See e.g. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 250, (1986)

(Anderson) ("the threshold inquiry of determining whether there is the need for a trial -- whether . . . there are any genuine factual issues that properly can be resolved only by a finder of fact because they may reasonably be resolved in favor of either party."). The administrative law judge must accept all evidence presented by the non-movant complainant as true, must view all of the evidence in the light most favorable to the non-movant complainant, and must draw all justifiable inferences in favor of non-movant complainant when deciding a motion for summary determination. See Anderson, 477 U.S. at 255. However, non-movant has the burden to submit more than averments in pleadings or allegations in legal memoranda to overcome a motion for summary determination. See Celotex Corp. v. Catrett, 477 U.S. 317, 324 (1986), Anderson, 477 U.S. 249-252. Mere denials or conclusory statements are insufficient. SRI International v. Matsushita Elec. Corp. of America, 775 F.2d 1107, 1116 (Fed. Cir. 1985) (SRI International). Summary determination may be properly decided as a matter of law when no genuine issue of material fact exists and no expert testimony is required to explain the nature of the patented invention or the accused product or to assist in their comparison. Amhil Enterprises Ltd. v. Wawa, Inc., 81 F.3d 1554, 1557 (Fed. Cir. 1996). The administrative law judge should "approach a motion for summary determination on [a] fact issue . . . with great care." Id. at 1557, SRI International at 1116 ("Because . . . infringement is itself a fact issue, a district court must approach a motion for summary judgement of infringement or non-infringement with a care proportioned to the likelihood of its being inappropriate."). The administrative law judge finds that, in response to Motion No. 392-27, complainant has not raised any issue of material fact.

The issue of patent invalidity is an issue of fact. See e.g. Scripps Clinic & Research Foundation v. Genentech, Inc., 927 F.2d 1565, 1577, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991) (Scripps Clinic), Glaxo Inc. v. Novopharm Ltd., 52 F.3d 1043, 1047 (Fed. Cir.), cert. denied, 1167 S.Ct. 516 (1995). Summary determination of anticipation does require that each and every element of the claimed invention be disclosed in a single prior art reference, Akzo, N.V. v. USITC, 808 F.2d 1471, 1479 (Fed. Cir. 1986) (Akzo), cert. denied, 482 U.S. 909 (1987); Lewmar Marine, Inc. v. Barient, Inc., 827 F.2d 744, 747 (Fed. Cir. 1987) (Lewmar Marine), cert. denied, 484 U.S. 1007 (1988), Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir.), cert. denied, 493 U.S. 859 (1989) (Richardson), Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986) (Hybritech). Because a patent is entitled to a statutory presumption of validity under 35 U.S.C. § 282, movants must establish invalidity by "clear and convincing" evidence. See Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1050 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988), Carella v. Starlight Archery & Pro Line Co., 804 F.2d 135, 138 (Fed. Cir. 1986).

In responding to Motion No. 392-27, complainant does not dispute that the Heathkit device is prior art to the '277 patent, and that the Heathkit device is a "television subscriber station" comprising a "converter," a "tuner" and a "television receiver or display device" as required by the first three elements of claim 35. See Respondents' Statement of Uncontroverted Facts, ¶¶ 8-11; Complainant's Response to Respondents' Statement of Uncontroverted Facts, ¶¶ 8-11. Moreover, complainant does not dispute movants' description of the Heathkit device as it relates to the claimed "controller," the final element

of claim 35, *Id.*, Compl. Reply. at 1 ("The Heath Kit . . . stored information which identifies *the channel and time* of a particular program."). Thus, complainant has not raised any issue of material fact as to what is disclosed in the Heathkit device that would preclude summary determination.

The sole issue raised by complainant in both its opposition to Motion No. 392-27, and in its reply to the staff's submission, is a question of law. Specifically, complainant disputes movants' and the staff's interpretation of the claim 35 phrase "information of a selected television program unit." That phrase is contained in the final element of claim 35, which reads:

a controller operatively connected to said tuner for storing information of a selected television program unit and causing said tuner to select a television transmission containing programming of said selected television unit at a specific time.

In deciding a motion for summary determination of anticipation, the administrative law judge must construe disputed claim language as a matter of law, see Markman v. Westview Instruments, Inc., 52 F.3d 967, 978, 34 USPQ2d 1321, 1328 (Fed. Cir. 1995) (en banc) affirmed 116 S.Ct. 1384, ___ U.S. ___, (1996) (Markman),⁷ Certain Electronic Products, Including Semiconductor Products Manufactured by Certain Processes, Inv. No. 337-TA-381, Comm'n Op. at 3-4 (October 15, 1996) (Electronic Products I) ("Claim interpretation is a question of law, for which the court has the discretion to consider extrinsic evidence, such as expert testimony, when it is necessary to understand the claim, or to disregard such evidence when the claim can be clearly understood from the patent's specification and

⁷ The Supreme Court, affirming the Federal Circuit, held that the construction of a patent, including terms of art within its claims, is exclusively within the province of a court. 116 S.Ct. at 1387-1396.

prosecution history"). The administrative law judge may, in his discretion, receive extrinsic evidence to aid him in coming to a correct conclusion as to the true meaning of language employed in a patent. Markman, 52 F.3d at 981, 34 USPQ2d at 1331.

Based on a review of the language of claim 35 and the '490 and '277 patent specifications, detailed infra, the administrative law judge finds that the claim term "information of a selected television program unit" is literally satisfied by channel and time information. Accordingly, as a matter of law in view of the Heathkit device (see infra) the administrative law judge finds that movants are entitled to summary determination that claim 35 is anticipated under 35 U.S.C. § 102(b).

It is undisputed that the identification of a channel and a time is "information." See Compl. Reply. at 1 ("The Heath Kit . . . stored information which identifies *the channel and time* of a particular program."). It is also undisputed that the phrase "selected television program unit" in claim 35 refers to a single television program, such as "Wall Street Week." See Compl. Op. at 3, Motion No. 392-27 at 7, Staff Resp. at fn 5. Thus, based strictly on the words of claim 35, the administrative law judge finds that the channel and time (information) of a particular television program (selected television program unit) is "information of a selected television program unit." Moreover, the administrative law judge finds infra that the specification of the '277 and '490 patents support this interpretation.

While examples in the specification can not add limitations to the claim, the specification (as well as the claims and file history) must be considered in determining the scope and meaning of claim language. A patentee is free to be his own lexicographer, although any special definition given to a word must be clearly defined in the specification.

Markman, 52 F.3d at 978, 979, 34 USPQ2d at 1328, 1329. However, reference to a preferred embodiment in a specification is not a claim limitation. Laitram Corp. v. Cambridge Wire Cloth Co., 863 F.2d 855, 865, 9 USPQ2d 1289, 1296 (Fed. Cir. 8), cert. denied, 490 U.S. 1068 (1989) (Laitram Corp.).

The administrative law judge finds that the phrase "information of a selected television program unit" is not explicitly defined in either the '277 or '490 patent specifications. The '277 patent specification does use the phrase "program-unit-of-interest information," which each of movants, complainant, and the staff argued is relevant to the appropriate definition of the claim phrase "information of a selected television program unit." The specification of the '277 patent also contains the following description of a "controller" for storing "program-unit-of-interest information:"

For example, all URS [ultimate receiver station] microcomputers . . . are preprogrammed with particular program-unit-of-interest information and with particular station-specific-television-program-selection-and-display instructions. Said program-unit-of-interest information includes information of particular television programs that the subscribers of the stations of said microcomputers, 205, wish to view when said programs are transmitted.

('277 patent Col. 238: 55-64). Thus, the term "information" follows the term "program unit" when used in the specification, while the word "information" precedes the term "program unit" in the language of claim 35. In addition the phrase "of interest" modifies the phrase "program unit" when used in the specification, while the term "selected" modifies the phrase "program unit" in claim 35. Finally, the specification states that "program-unit-of-interest information includes information of particular television programs." Based on these similarities in usage in the specification and the claim, the administrative law judge finds that discussions of "program-unit-of-interest information" are directly relevant to an

understanding of the claim 35 phrase "information of a selected television program unit" as that phrase is used in claim 35.

The specification with respect to example #7 further teaches regarding the programming of a controller:

In example #7, the intermediate station that retransmits "wall Street Week" program information to the subscriber station of FIG. 4 . . . transmits the information of said program on cable channel 13, commencing at a particular 8:30 PM time on a particular Friday night.

In example #7, the controller, 20, of the signal processor, 200, of FIG. 4 is preprogrammed at a particular time with particular information that indicates that the subscriber of said station wishes to view said "Wall Street Week" program when transmission of said program on cable [channel] 13⁸ commences.

(So preprogramming controller, 20, can occur in several fashions. For example, prior to a particular time, a subscriber may enter particular please-fully-enable-WSW-on-CC13-at-particular-8:30 information at local input, 225, and cause said information, in a predetermined fashion, to be inputted to controller, 20, by local input, 225. Alternatively, microcomputer, 205, can be preprogrammed with particular specific-WSW information and, in a predetermined fashion that is described more fully below, caused to input said please-fully-enable-WSW-on-CC13-at-particular-8:30 information to said controller.)

'277 patent, col. 162, lines 44-61 (emphasis added). Based on that example #7 in the '277 specification, the administrative law judge find that "particular please-fully-enable-WSW-on-CC13-at-particular-8:30 information," is "channel and time" information for a selected television program unit, viz. "Wall Street Week." Moreover, that "channel and time information" ("particular please-fully-enable-WSW-on-CC13-at-particular-8:30 information") may either be input directly by a subscriber to a controller via local input, or

⁸ The '277 patent specification at col. 162, ln. 49 reads "cable cable 13." However, it is clear that said text should read "cable channel 13." See, '277 patent, col. 162, ln. 42.

"[a]lternatively, microcomputer, 205, can be preprogrammed with particular specific-WSW information and . . . caused to input said please-fully-enable-WSW-on-CC13-at-particular-8:30 information to said controller." The administrative law judge finds that that section of the specification supports the administrative law judge's conclusion that "information of a selected television program unit" can include "channel and time" information and in the instance of example #7 that information is "please-fully-enable-WSW-on-CC13-at-particular-8:30 information."

Example #7 continues in defining program-unit-of-interest information, in relation to "please-fully-enable-WSW-on-CC13-at-particular-8:30 information:"

The program-unit-of-interest information preprogrammed at the microcomputer, 205, of the station of FIGS. 7 and 7C includes particular specific-WSW information that reflects the wish of the subscriber of said station to view (or record) said "Wall Street Week" program when said program is transmitted.

* * *

Executing said determine-whether-to-select instructions causes microcomputer, 205, to input said please-fully-enable-WSW-on-CC13-at-particular-8:30 information to the controller, 20, of signal processor, 200. Said instructions contain one instance, and the aforementioned program-unit-of-interest information that is preprogrammed at said microcomputer, 205, contains a second instance of specific-WSW information, which second instance reflects the wish of the subscriber of said station to view (or record) said "Wall Street Week" program when said program is transmitted. Automatically, microcomputer, 205, compares said one instance to said program-unit-of-interest information and determines a match with said second instance. Determining a match causes microcomputer, 205, automatically to input said please-fully-enable-WSW-on-CC13-at-particular-8:30 information to the controller.

'277 patent, col. 239, lines 3-8, col. 243, lines 37-54 (emphasis added). In the foregoing section of the '277 patent specification, the "determine-whether-to-select instructions" contains a "first instance" of "specific-WSW information," viz. "please-fully-enable-WSW-

on-CC13-at-particular-8:30 information" while the "program-unit-of-interest information" is a second instance of "specific-WSW information." Thus, "determine-whether-to-select instructions" and "program-unit-of-interest information" are each defined as "specific-WSW information." In example #7 of the '277 specification, the "determine-whether-to-select instructions" and "program-unit-of-interest information" are compared, and if said information is the same, certain "please-fully-enable-WSW-on-CC13-at-particular-8:30 information" is input to the controller. Said "please-fully-enable-WSW-on-CC13-at-particular-8:30 information," input to the controller then causes the tuner to tune to the proper channel ('277 patent cols. 243: 37 - 244: 6, col. 165: 48-51). The administrative law judge finds that this example does not exclude the possibility that the "determine-whether-to-select instructions" and "program-unit-of-interest information" could each be limited to "time and channel" information. Instead, said information could be satisfied by "please-fully-enable-WSW-on-CC13-at-particular-8:30 information," which is "channel and time" information.

While neither the claim 35 phrase "information of a selected television program unit" nor the '277 patent specification phrase "program-unit-of-interest information" are used in the '490 specification, the specification of the '490 patent⁹ provides the following example relating to the claim 35 "controller" element:

In another example microcomputer, 205 may be preinformed that a certain television program, hypothetically "Wall Street Week," should be televised on TV set, 202, when it is cablecast. Microcomputer, 205, is preinformed of the

⁹ U.S. Patent No. 4, 694,490 issued from the application from which the '277 patent (the patent-in-suit) claims priority. Complainant argued that claim 35 is entitled to the filing date of the '490 patent.

time of cablecasting. When that time comes, microcomputer, 205, receives no program identification signals whatever from TV signal decoder, 203, which indicates that the set, 202, is not on. Microcomputer, 205, instructs signal processor, 200, to pass all program and channel identifiers on all programming being cablecast on the multi-channel system. Signal processor, 200, receives this instruction from microcomputer, 205, at its processor or monitor, 12, which reacts, in a predetermined fashion by passing also externally to microcomputer, 205, all signals that it passes to buffer/comparator, 14. Analyzing these identifier signals in a predetermined fashion, microcomputer, 205, determines that "Wall Street Week" is being televised on channel X. Then in a predetermined fashion, microcomputer, 205, may instruct tuner, 214, to switch box, 201, to channel X.

'490 patent Col. 19: 5-25 (emphasis added). As seen from said passage, the '490 specification states that "microcomputer, 205 may be preinformed that a certain television program, hypothetically "Wall Street Week," should be televised on TV set, 202, when it is cablecast. Microcomputer, 205, is preinformed of the time of cablecasting." Thus, the microcomputer is preinformed of the time that the program will be cablecast. The specification also calls for distinct "program and channel identifiers" for all programming. Said identifier signals are analyzed to determine that a certain television program is being televised on a given channel, and the tuner is then switched to the appropriate channel. However, no indication is given in the '490 specification that "program and channel identifiers" could not include only "time and channel" information.

The specification of the '490 patent also contains a discussion of a "unique program code." Thus, the '490 patent specification provides the following discussion in relation to a "intermediate transmission point":

The controller/computer, 73, has means for receiving input information from local input, 74, . . . Such input information might include the cable television system's complete programming schedule, with each discrete unit of programming identified with a unique program code (which in the case of advertising might be a purchase order number.) Such input information might

also indicate when and where the cable head end facility should expect to receive the programming. Such input information might also indicate when and on which channel or channels the head end facility should transmit each program unit . . .

('490 patent Col. 11: 18-30 (emphasis added)). However, the cited passage of the '490 specification indicates that certain "input information" used "might" include a "unique program code" and also "might" indicate time and channel information. Thus, the specification teaches that "input information" can include "when and on which channel" each program unit will be transmitted. There is no indication in this portion of the '277 patent specification that "information of a selected television program unit" must include more than "time and channel" information.

Complainant, in their reply, argued that the distinction between information that identifies the program and information that identifies the channel and time is what allows the system of claim 35 to provide the described functionality; that the system uses the program unit information to scan all channels in order to determine what channel the desired program is on; and that, if program unit information included channel information, this functionality would be pointless. The administrative law judge rejects complainant's argument that channel and time information would not provide the "functionality" of claim 35. As detailed in example #7 of the '277 specification, he finds that if the "information of a selected television program unit" stored in the claimed "controller" were simply channel and time information, said information would allow the claimed controller to "caus[e] said tuner to select a television transmission containing programming of said selected television unit at a specific time" as required by claim 35. Specifically, if the "selected television program unit," for example "Wall Street Week" was to appear on cable channel 13 at 8:30, the

administrative law judge finds that the "information" that said program was on channel 13 and 8:30, or "WSW-on-CC13-at-particular-8:30 information," could be stored in the claimed controller, and the claimed controller could thereafter "cause[e] said tuner to select" channel 13 at "a specific time" viz. 8:30, and the "television transmission containing programming of said selected television unit," viz. "Wall Street Week," appearing on channel 13 at 8:30, would be selected (see '277 patent, col. 162, lns. 44-61, col. 239, lines 3-8, col. 243, lines 37-54, supra). Said example would provide the functionality of claim 35.¹⁰

Based on the foregoing review of the language of claim 35 and the '490 and '277 patent specifications, the administrative law judge finds, as a matter of law, that the disputed phrase "information of a selected television program unit" is satisfied by channel and time information. Because claim interpretation is solely a question of law, the administrative law judge may properly interpret disputed claim language in a motion for summary determination. See Markman, 52 F.3d at 979, 983-84, 34 USPQ2d at 1329, 1333. The question of what the Heathkit device discloses and hence the issue of anticipation is a question of fact, See Scripps Clinic, 927 F.2d at 1577, 18 USPQ2d at 1010, Glaxo, 52 F.3d at 1047, Electronic Products I, Comm'n Op. at 4, Certain Electronic Products, Including Semiconductor Products Manufactured by Certain Processes, Inv. No. 337-TA-381, Comm'n Op. at 17 (October 30, 1996) (Electronic Products II), Certain Condensers, Parts Thereof and Products Containing Same, Including Air Conditioners for Automobiles, Inv. No. 337-TA-334, Comm'n Op. at 5 (November 25, 1992) (Condensers). However, in responding to

¹⁰ The administrative law judge finds nothing in the language of claim 35 that would require the controller of claim 35 to "scan all channels in order to determine what channel the desired program is on." See Compl. Reply at 5.

Motion No. 392-27 complainant has agreed to the characterization of the Heathkit device contained in Motion No. 392-27 and respondent's statement of facts. Thus, contrary to the issues presented in Order No. 36 in this investigation (finding issue of fact regarding teaching of a Marti reference), as well as the issues presented in Electronic Products I, Electronic Products II, and Condensers,¹¹ there is no issue of fact presented as to what is disclosed by the Heathkit device that can be decided in favor of complainant. See supra.

Based on the foregoing, the administrative law judge finds that complainant has not established any genuine issue of material fact regarding the anticipation of claim 35 by the Heathkit device. The administrative law judge finds, as a matter of law, that the final element of claim 35 merely requires storing information of the channel and time of a particular program, and complainant admits that "The Heath Kit . . . stored information which identifies the channel and time of a particular program." Compl. Reply. at 1.

Moreover, complainant has not disputed that the Heathkit device contains all other elements of claim 35. Accordingly, because the Heathkit device contains each and every element of claim 35 in issue, claim 35 is found invalid as a matter of law.. See e.g. Akzo, 808 F.2d at 1479, Lewmar Marine, 827 F.2d at 747, Richardson, 868 F.2d at 1236.

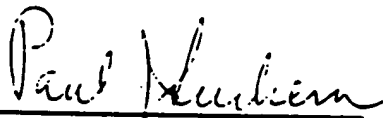
Motion No. 392-27 is hereby granted.

¹¹ In Condensers, the Commission found that "inferences drawn from the prosecution history in deciding motions for summary determination must be drawn in favor of the nonmovant." Comm'n Op. at 5, citing Lemelson v. TRW, Inc., 760 F.2d 1254, 1266 (Fed. Cir. 1985). Although it is appropriate to consider the prosecution history in determining the scope of patent claims as a matter of law, see Markman, 52 F.3d at 978, 979, 34 USPQ2d at 1328, 1329, complainant has not cited to the prosecution history of the '277 patent for support of its interpretation of claim 35.

This initial determination is hereby CERTIFIED to the Commission, together with supporting documentation. Pursuant to Commission rule 210.42(c) and 210.42(h)(3), this initial determination shall become the determination of the Commission within thirty (30) days after the date of service hereof unless the Commission, within 30 days after the date of such service shall have ordered review of the initial determination or certain issues therein or by order has changed the effective date of the initial determination.¹²

This initial determination will be made public unless a bracketed confidential version of the initial determination is received by the administrative law judge no later than the close of business on May 23.

On May 16, 1997, the private parties and the staff were notified about the issuance of this order.


Paul J. Luckern
Administrative Law Judge

Issued: May 16, 1997


¹² Pursuant to Order No. 30, the evidentiary hearing in this investigation is scheduled to commence on June 30, 1997.

**CERTAIN DIGITAL SATELLITE SYSTEM (DSS)
RECEIVERS AND COMPONENTS THEREOF**

Inv. No. 337-TA-392

CERTIFICATE OF SERVICE

I, Donna R. Koehnke, hereby certify that the attached Order was served by hand upon Smith R. Brittingham, IV, Esq., and upon the following parties via first class mail, and air mail where necessary, on MAY 21, 1997.


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**CERTAIN DIGITAL SATELLITE SYSTEM (DDS)
RECEIVERS AND COMPONENTS THEREOF**

Inv. No. 337-TA-392

CERTIFICATE OF SERVICE - p. 2

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**CERTAIN DIGITAL SATELLITE SYSTEM (DDS)
RECEIVERS AND COMPONENTS THEREOF**

Inv. No. 337-TA-392

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